

### **REMARKS/ARGUMENTS**

In the Office Action mailed September 22, 2005, claims 1-10 and 20-30 were rejected. Claims 1-3, 20, 25 and 27-28 have been amended to better define the invention. Claims 4-7, 11-19, 21-23 and 26 have been cancelled without prejudice or disclaimer. Furthermore, new claims 31-47 have been added. Support for the amendments is found in the specification, and no new matter is added. As such, claims 1-3, 8-10, 20, 24-25 and 27-47 remain pending in the application.

Applicants have thoroughly reviewed the outstanding Office Action including the Examiner's remarks and the references cited therein. The following remarks are believed to be fully responsive to the Office Action. All the pending claims at issue are believed to be patentable over the cited references.

### **CLAIM REJECTIONS – 35 U.S.C. § 102**

Claims 1-10 and 20-30 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,460,064 to Zayat, Jr. (hereinafter referred to as "Zayat"). Applicants respectfully traverse these rejections. In light of the following remarks, Applicants respectfully submit that these claims are allowable.

Initially, Applicants note that it is axiomatic that the Section 102 rejection is proper "only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference" – i.e., the prior art must teach every aspect of the claim. *See Verdegall Bros. v. Union Oil Co. of California*, 918 F.2d 628, 631 (Fed. Cir. 1987); *see also* M.P.E.P. § 2131.

Zayat does not teach or suggest a combination recited by Applicants' claims as is required for a rejection under 35 U.S.C. § 102(b). For example, Applicants' independent claim 1 and its dependent claims 2-3, 8-10 and 31-42 recite, in part, "a socket bit holder having a first

end and a second end, the first end comprising a socket bit receptacle and a continuous concave surface surrounding the socket bit receptacle, and the second end comprising a socket drive receptacle.”

In contrast, Zayat discloses a universal socket tool including a housing with an open lower end. (*See Zayat, Abstract.*) An array of square pins is suspended in sliding relation to the housing with the lower ends of the pins arranged for engagement with a plurality of different fastening elements. (*See id.*) Selected pins include tapered lower ends for engagement with a slotted screw heads. (*See id.*) However, the universal socket tool of Zayat does not include at least a continuous concave surface surrounding a socket bit receptacle.

Thus, Zayat does not teach or suggest every aspect of Applicants’ independent claim 1 and its dependent claims 2-3, 8-10 and 31-42, because Zayat does not include each and every element, as set forth in Applicants’ claims. At least for these reasons, Applicants respectfully request that the rejections under Section 102 as being anticipated by Zayat be removed with respect to claim 1 and its dependent claim 2-3 and 8-10.

With respect to claims 20-30, Zayat does not teach or suggest a combination recited by independent claim 20 and its dependent claims 24-25, 27-30 and 43-47. Applicants’ claim 20 and its dependent claims recite, in part, “[a] system for removing a fastener having an insertion receptacle from an assembly, comprising[] means for inserting into the insertion receptacle; means for retaining the inserting means such that the inserting means protrudes a predetermined distance from the retaining means; [and] means for aligning the fastener with the retaining means....”

In contrast, Zayat discloses a universal socket tool including a housing with a plurality of individual pins slidably suspended within the housing, as described above. In one embodiment of Zayat, a pin suspension system includes plates with apertures for receiving the upper ends of the pins, which have a flange that limits the travel of the pins such that the pins cannot protrude from the housing. (*See Zayat, Abstract and FIGs. 3-9.*) Another embodiment of Zayat includes

springs secured at one end to the upper end of each pin and at a second end to retainer elements. (See Zayat, Abstract and FIGs. 12 & 13.) Yet another embodiment of Zayat includes springs secured at one end to the upper end of each pin and imbedded at a second end in an adhesive medium in the housing. (See Zayat, Abstract and FIG. 15.) However, none of the embodiments of Zayat include inserting means that protrudes a predetermined distance from a retaining means. Similarly, the universal socket tool of Zayat does not include an aligning means.

Thus, Zayat does not teach or suggest every aspect of Applicants' independent claim 20 and its dependent claims 24 and 43-47, because Zayat does not include each and every element, as set forth in Applicants' claims. At least for these reasons, Applicants respectfully request that the rejections under Section 102 as being anticipated by Zayat be removed with respect to claim 20 and its dependent claims 24-25 and 27-30.

Claims 1-10 and 20-30 were also rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,047,620 to Kozak, et al. (hereinafter referred to as "Kozak"). Applicants respectfully traverse these rejections. In light of the following remarks, Applicants respectfully submit that these claims are allowable.

Kozak does not teach or suggest a combination recited by Applicants' claims, as is required for a rejection under 35 U.S.C. § 102(b). For example, Applicants' independent claim 1 and its dependent claims 2-3, 8-10 and 31-42, recite, in part, "a socket bit holder having a first end and a second end, the first end comprising a socket bit receptacle and a continuous concave surface surrounding the socket bit receptacle, and the second end comprising a socket drive receptacle."

In contrast, Kozak discloses a tool for removing a conventional type one-way fastener including a shank and a collar. (See Kozak, col. 3, ll. 31-39.) The collar of Kozak includes an upper wall that receives the shank via a passageway and a lower wall that includes a fastener recess. (See Kozak, col. 4, ll. 12-14.) The recess of Kozak is configured from a plurality of planar walls and an equal number of arcuate walls extending parallel to the longitudinal axis of

the collar. (*See* Kozak, col. 4, ll. 15-17.) However, the tool of Kozak does not include at least a continuous concave surface surrounding a socket bit receptacle. Furthermore, although an embodiment disclosed in Kozak includes a passageway that receives a shank, none of the embodiments of Kozak include both a socket bit receptacle and a socket drive receptacle.

Thus, Kozak does not teach or suggest every aspect of Applicants' independent claim 1 and its dependent claims 2-3, 8-10 and 31-42, because Kozak does not include each and every element as set forth in Applicants' claims. At least for these reasons, Applicants respectfully request that the rejections under Section 102 as being anticipated by Kozak be removed with respect to claim 1 and its dependent claims 2-3 and 8-10.

With respect to claims 20-30, Kozak does not teach or suggest a combination recited by independent claim 20 and its dependent claims 24-25, 27-30 and 43-47. Applicants' claim 20 and its dependent claims recite, in part, "means for inserting into the insertion receptacle; means for retaining the inserting means...; means for aligning the fastener with the retaining means; and means for receiving a socket drive."

In contrast, as explained above, Kozak discloses a tool for removing a conventional type one-way fastener, including a shank and collar. The collar of Kozak has an upper wall that receives the shank via a passageway and a lower wall that includes a fastener recess. The tool of Kozak does not include at least means for inserting, means for retaining the inserting means, and means for receiving a socket drive in a single embodiment. In the various embodiments of Kozak, the shank can be replaced by a recess in the upper wall of the collar to receive a ratchet lug. (*See* Kozak, col. 7, ll. 4-10.) However, Kozak does not teach or suggest means for inserting combined with means for receiving a socket drive.

Thus, Kozak does not teach or suggest every aspect of Applicants' independent claim 20 and its independent claims 24-25 and 27-30, because Kozak does not include each and every element, as set forth in Applicants' claims. At least for these reasons, Applicants respectfully request that the rejections under Section 102 as being anticipated by Kozak be removed with

respect to claim 20 and its dependent claims 24-25 and 27-30.

### **CLAIM REJECTIONS – 35 U.S.C. § 103**

In the alternative, claims 1-10 and 20-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Zayat. Applicants respectfully traverse these rejections. In light of the following remarks, Applicants respectfully submit that these claims are allowable.

The Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. *MPEP* §2142. To establish a prima facie case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, to modify the references or to combine reference teachings. Second, there must be reasonable expectation of success. Finally, the prior art must teach all the claim limitations. *MPEP* §2142.

With respect to claims 1-10, Zayat does not teach or suggest a combination recited by independent claim 1 and its dependent claims 2-3, 8-10 and 31-42. Applicants' claim 1 and its dependent claims recite, in part, "a continuous concave surface surrounding [a] socket bit receptacle." As explained above, Zayat discloses a universal socket tool having a housing with a plurality of individual pins slidably suspended within a housing. Zayat does not disclose a continuous concave surface surrounding a socket bit receptacle.

An advantage of the apparatus for removing a fastener is that the concave surface is designed to mate with the head of a fastener to urge the bit holder into a generally perpendicular relationship with the bolt head to provide a desirable alignment. (*See* Specification, para. 24 and 31.) The individual pins of Zayat are not capable of performing this function, and it is not obvious how the pins could be modified to perform this function.

Accordingly, Zayat fails to teach or suggest a combination including all of the elements of Applicants' independent claim 1 and its dependent claims 2-3, 8-10 and 31-42. Therefore, at

least for these reasons Applicants respectfully request that the Examiner remove the rejection of claim 1 and its dependent claims 2-3 and 8-10 under 35 U.S.C. § 103(a) as obvious over Zayat.

With respect to claims 20-30, Zayat does not teach or suggest a combination recited by independent claim 20 and its dependent claims 24-25, 27-30 and 43-47. For example, claim 20 and its dependent claims recite, in part, “means for inserting into the insertion receptacle [and] means for retaining the inserting means such that the inserting means protrudes a predetermined distance from the retaining means....”

In contrast, as described above, Zayat discloses a universal socket tool with a plurality of individual pins slidably suspended within a housing. (*See* Zayat, col. 3, ll. 31-37.) Nowhere does Zayat disclose inserting means protruding a predetermined distance from the retaining means. On the contrary, the pins of Zayat can be forced upwardly into the housing to a second position. (*See* Zayat, col. 5, ll. 35-38.) Given the intended function of the universal socket tool of Zayat, it would not be obvious to modify the pins to protrude a predetermined distance from the housing.

Thus, Zayat fails to teach or suggest a combination including all of the elements of Applicants’ independent claim 20 and its dependent claims 24-25, 27-30 and 43-47. Therefore, at least for these reasons, Applicants respectfully request the rejections of claim 20 and its dependent claims 24-25 and 27-30 under 35 U.S.C. § 103(a) as obvious over Zayat be withdrawn.

Furthermore, claims 1-10 and 20-30 were rejected under 35 U.S.C. § 103(a) as being obvious over Kozak. Applicants respectfully traverse these rejections. In light of the following remarks, Applicants respectfully submit these claims are allowable.

With respect to claims 1-10, Kozak does not teach or suggest that the combination recited by Applicants’ independent claim 1 and its dependent claims 2-3, 8-10 and 31-42. Applicants’ claim 1 and its dependent claims recite, in part, “a continuous concave surface surrounding [a] socket bit receptacle....” As explained above, the collar of Kozak does not have at least a continuous concave surface surrounding a socket bit receptacle.

In contrast, the collar of Kozak as an upper wall that receives the shank via a passageway, and a lower wall that includes a fastener recess. Kozak suggests replacing the shank with a recess in the upper wall of the collar to receive an engagement lug protruding from a ratchet. (See Kozak, col. 7, ll. 4-10.) However, Kozak does not suggest a combination including means for inserting, means for retaining the inserting means and means for receiving a socket drive. Kozak does not suggest combining means for inserting and means for retaining the inserting means with means for receiving a socket drive. It is not obvious how the tool of Kozak could be modified to include means for inserting and means for retaining the inserting means, along with means for receiving a socket drive.

Accordingly, Kozak fails to teach or suggest a combination including all of the elements of Applicants' independent claim 20 and its dependent claims 24-25 and 27-30. Therefore, at least for these reasons, Applicants' respectfully request the rejection of claim 20 and its dependent claims 24-25 and 27-30 under 35 U.S.C. § 103(a) as obvious be withdrawn.

### **CLAIM REJECTIONS – 35 U.S.C. § 112, second paragraph**

In the current Office Action, claims 1-10 and 20-30 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Specifically, the Office Action stated that these claims were indefinite because of the use of trademarks therein. While not conceding the propriety of these rejections, claims 4-7 and 22-23 have been cancelled. The remaining claims 1-3, 8-10, 20, 24-25 and 27-47 do not include the use of trademarks. Accordingly, at least for these reasons, Applicants respectfully request that the rejections of claims 1-3, 8-10, 20, 24-25 and 27-30 under 35 U.S.C. § 112, second paragraph, as being indefinite be removed.

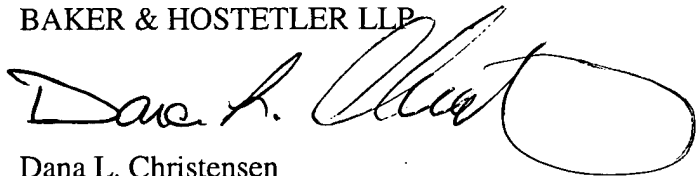
### CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. If it is believed that the application is not in condition for allowance, the Examiner is requested to contact the undersigned attorney at 202-861-1567 if it is believed that such contact will expedite the prosecution of the application.

In the event this paper is not timely filed, Applicants petition for an appropriate extension of time. Please charge any fee deficiencies or credit any overpayments to Deposit Account No. 50-2036 with reference to Attorney Docket No. 87355.9080.

Respectfully submitted,

BAKER & HOSTETLER LLP

A handwritten signature in black ink, appearing to read "Dana L. Christensen", with a large, stylized circular flourish at the end.

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